

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jan BATZER et al.

Confirmation No. 6148

Group Art Unit: 1612

Serial No. : 10/824,102

Examiner: Webb, Walter E

Filed : April 13, 2004

For : COSMETIC OR DERMATOLOGICAL ACTIVE INGREDIENT
COMBINATION

REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer mailed March 5, 2009, the period for reply extending until May 5, 2009.

In the Examiner's Answer the Examiner has withdrawn the rejection of claims 1 and 2 on the ground of nonstatutory obviousness-type double patenting over claims 1 and 11 of copending Application No. 10/871,819 and has maintained all other rejections.

Appellants note that the Examiner's Answer does not sufficiently address Appellants' arguments as to why the rejections are without merit. This deficiency has prompted the present Reply Brief.

Appellants also note that this Reply Brief is being filed under 37 C.F.R. § 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief.

In order to avoid repetition, the following response to the Examiner's arguments in the Examiner's Answer will be limited to issues which are important enough to warrant a further comment in Appellants' opinion. Accordingly, Appellants' silence with respect to any allegations set forth in the Examiner's Answer which are not specifically addressed below should by no means be construed as Appellants' admission that these allegations are of any merit.

REPLY

In response to Appellants' argument that the rejection does not explain why one of ordinary skill in the art would have had an apparent reason to choose 8-hexadecene-1,16-dicarboxylic acid from the host of different dicarboxylic acids which are encompassed by general formula (2) of HARDING (U.S. Patent No. 5,705,144), i.e.,



wherein a is an integer of from 6 to 20 and b is an integer of from 8 to 40;

the Examiner states in the paragraph bridging pages 6 and 7 of the Examiner's Answer (underlining provided):

... However, 8-hexadecene-1,16-dicarboxylic acid would have been immediately envisaged since it is a compound of structure 2 of [HARDING] where a is 16 and b is 30. It was explained previously that 8-hexadecene-1,16-dicarboxylic acid is encompassed by the formula of [HARDING], and that the compounds of this formula are useful in compositions for topical application to human skin. As Appellant's invention is drawn to a dermatological composition, it would have been obvious at the time of applicant's invention to use a compound of the formula of [HARDING] in a dermatological composition. Furthermore, applicants provide no evidence of unexpected results in regard to 8-hexadecene-1,16-dicarboxylic acid.

Appellants respectfully disagree with the Examiner in this regard and point out again that the mere fact that 8-hexadecene-1,16-dicarboxylic acid is encompassed by

general formula (2) of HARDING, i.e., a formula which encompasses about thousand different saturated and unsaturated dicarboxylic acids (without taking into account stereoisomers and under the assumption that the general formula of HARDING is not intended to encompass any dicarboxylic acids with a branched alkylene chain or a cycloalkylene structure) is clearly not sufficient to cause one of ordinary skill in the art to "immediately envisage" each and every specific acid among this host of dicarboxylic acids. For example, even the formula $\text{COOH}-(\text{C}_{16}\text{H}_{30})-\text{COOH}$ (i.e., where in general formula (2) of HARDING $a = 16$ and $b = 30$) encompasses not only 8-hexadecene-1,16-dicarboxylic acid but also 2-hexadecene-1,16-dicarboxylic acid, 3-hexadecene-1,16-dicarboxylic acid, 4-hexadecene-1,16-dicarboxylic acid, 5-hexadecene-1,16-dicarboxylic acid, 6-hexadecene-1,16-dicarboxylic acid and 7-hexadecene-1,16-dicarboxylic acid (again under the assumption that this formula does not encompass branched acids or acids with a ring structure).

Appellants also note again that "[t]he fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious." *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)); see also *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943, *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995), and MPEP 2144.08.

In this regard, it further must be taken into account that HARDING fails to provide any pointers whatsoever which would direct the attention of one of ordinary skill in the art to 8-hexadecene-1,16-dicarboxylic acid. On the contrary, HARDING is silent regarding a commercial source or possible synthetic methods for the preparation of 8-hexadecene-1,16-dicarboxylic acid. Further, not a single one of the dioic acids which are

employed in the numerous exemplified compositions of HARDING, whether saturated, mono- or di-unsaturated, contains 16 carbon atoms. Even further, in addition to the various dicarboxylic acids which are employed in the Examples thereof, HARDING expressly mentions a number of specific dicarboxylic acids which are encompassed by general formula (2). In view thereof, there clearly is no apparent reason for one of ordinary skill in the art to explore cosmetic compositions which contain dicarboxylic acids which are not specifically mentioned in HARDING and in particular, a cosmetic composition which comprises 8-hexadecene-1,16-dicarboxylic acid. In this regard, it also is to be taken into account that in view of the extremely large number of dicarboxylic acids which are encompassed by general formula (2) it would not be reasonable to assume that each and every of these acids will afford the favorable results claimed by HARDING. In other words, from the disclosure of HARDING it is not even predictable that a specific acid such as 8-hexadecene-1,16-dicarboxylic acid which is not mentioned in HARDING will afford the favorable results claimed therein.

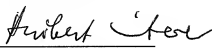
It further is pointed out that because for at least all of the reasons set forth above, the Examiner has failed to establish a *prima facie* case of obviousness of the subject matter of any of the rejected claims, there is no need for Appellants to provide "evidence of unexpected results in regard to 8-hexadecene-1,16-dicarboxylic acid".

CONCLUSION

The request to reverse the rejection of claims 1, 2 and 5-11 and to return the application to the Examining Group for prompt allowance is respectfully maintained.

Although no fee is believed to be required for entry of this Reply Brief, the Patent and Trademark Office is hereby authorized to charge any fee that is deemed to be necessary to Deposit Account No. 19-0089.

Respectfully submitted,
Jan BATZER et al.



Neil F. Greenblum
Reg. No. 28,394

May 4, 2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Heribert F. Muensterer
Reg. No. 50,417